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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,237	08/16/2001	Quintin T. Phillips	10006507-1	4805

7590 03/24/2009
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

VAN BRAMER, JOHN W

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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03/24/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/932,237

Applicant(s)

PHILLIPS ET AL.

Examiner

JOHN VAN BRAMER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/24/2008 (BPAI Decision).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 12-19 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 12-19 and 21-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Board Decision

1. The Board Decision dated November 24, 2006, affirmed the rejection of Claims 8-11. Therefore, the 35 U.S.C. 102(e) rejection of Claims 8-11 is maintained as being anticipated by Shimbori et al. (PGPUB: US 2004/0204986). Additionally, the Board raised a new grounds of rejection for claim 20. The appellant has neither reopened prosecution nor requested a rehearing within the required two months from the date of the decision. Thus, the 35 U.S.C. 112, second paragraph rejection of claim 20, and claim 25 by virtue of dependency is maintained. No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. 1.136(a). Thus the currently pending claims addressed below are claims 1-7; 12-19; and 21-24.
2. The rejection below is based upon the interpretation of the claims set forth in the Board Decision dated November 24, 2008. The term "association" is interpreted to mean "the state of being joined together" (Board Decision; Page 10, lines 12-18). Monitoring the association of a consumable with an image forming device is broad and encompasses monitoring the amount of paper that is joined with a printer, but does not encompass monitoring printing or the type of paper by the printing monitoring unit (Board Decision; Page 10, lines 12-18). Enabling communication of the marketing message to the image forming device user responsive to the monitoring actually requires that the device participate in communicating the

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marketing message and not just enable that it can occur (Board Decision Page 10, line 19 through Page 11, line 3). The examiner was aware of another prior art that teaches the applicant's claims in light of the Board Decision. Thus, the prior art of Hayward et al. (U.S. Patent Number: 6,798,997) has been used to reject claims 1-7; 12-19 and 21-24 as detailed below.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1- 7, 12-19 and 21-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Hayward et al. (U.S. Patent Number: 6,798,997).

Claim 1: Hayward discloses an article of manufacture comprising:

- a. A processor-usable medium having processor-useable code embodied therein and configured to cause processing circuitry to perform steps comprising:
 - i. Providing a marketing message intended for an image forming device user from a party other than a provider of a consumable. (Fig 3, Fig 4, Fig 6, Col 1,

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line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)

- ii. Monitoring an association of a consumable with an image forming device. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)
- iii. Enabling communication of the marketing message to the image forming device user responsive to the monitoring. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)

Claim 2: Hayward discloses the article of claim 1 wherein the monitoring comprises monitoring coupling of the consumable and the image-forming device. (Col 2, lines 52-63; Col 5, lines 5-39; Col 5, line 62 through Col 6, line 13; Col 8, lines 26-45; and Col 9, lines 26-33)

Claim 3: Hayward discloses the article of claim 1 wherein the enabling comprises accessing the marketing message from a memory device of the consumable. (Fig 6, Col 5, line 62 through Col 6, line 13; and Col 6, line 64 through Col 7, line 18)

Claim 4: Hayward discloses the article of claim 1 wherein the enabling comprises accessing an identifier of the marketing message from a memory device of the consumable. (Fig 6, Col 5, line 62 through Col 6, line 13; Col 6, line 64 through Col

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7, line 18; and Col 7, line 37 through Col 8, line 25);

Claim 5: Hayward discloses the article of claim 1 wherein the enabling comprises communicating the marketing message to the image-forming device. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)

Claim 6: Hayward discloses the article of claim 1 wherein the providing comprises providing the marketing message comprising a message unrelated to the consumable and unrelated to the image forming device. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67) (When the message is a form to be completed by the user, the actual form itself is a message and is not directly related to the image forming device nor the consumable.)

Claim 7: Hayward discloses the article of claim 1 wherein the code is further configured to cause the processing circuitry to perform the step including offering the marketing message to parties other than providers of the consumable and the providing is responsive to the offering. (Col 2, lines 2-4; Col 3, lines 65-67; and Col 9, lines 43-67)

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Claim 8: Hayward discloses a marketing method to image forming device users comprising:

- a. Providing a consumable usable in an image forming device to form hard images and usable to enable a marketing function with respect to image forming device users. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)
- b. Making available the marketing function to other parties apart from a provider of the consumables. (Col 2, lines 2-4; Col 3, lines 65-67; and Col 9, lines 43-67)
- c. Receiving an indication regarding a desirous party to utilize the marketing function. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)
- d. Enabling the marketing function for the desirous party using the consumable. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)
- e. Initiating the marketing function after the enabling. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)

Claim 12: Hayward discloses the method of claim 8 further comprising detecting a triggering event with respect to the consumables and wherein the initiating is responsive to the detecting. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)

Claim 13: Hayward discloses the method of claim 12 wherein the initiating comprises communicating a marketing message. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)

Claim 14: Hayward discloses the method of claim 12 wherein the detecting the triggering event comprises detecting coupling of the consumable with an image-forming device. (Col 2, lines 52-63; Col 5, lines 5-39; Col 5, line 62 through Col 6, line 13; Col 8, lines 26-45; and Col 9, lines 26-33)

Claim 15: Hayward discloses the method of claim 12 wherein the detecting the triggering event comprises detecting a condition of the consumable reaching a predetermined level. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)

Claim 16: Hayward discloses the method of claim 8 wherein the

- a. Providing the consumable comprises providing the consumable configured to enable the marketing function comprising communication of a marketing message associated with the desirous party. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)

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- b. The consumable comprises memory device configured to store the marketing message. (Fig 6, Col 5, line 62 through Col 6, line 13; and Col 6, line 64 through Col 7, line 18)
- c. The enabling comprises storing the marketing message using the memory device. (Fig 6, Col 5, line 62 through Col 6, line 13; and Col 6, line 64 through Col 7, line 18)
- d. The initiating comprises accessing the marketing message from the memory device and communicating the marketing message using the image-forming device after the accessing. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)

Claim 17: Hayward discloses the method of claim 8 wherein

- a. The consumable comprises a memory device. (Fig 6, Col 5, line 62 through Col 6, line 13; and Col 6, line 64 through Col 7, line 18)
- b. The enabling comprises storing an identifier within the memory device to identify the marketing function for the desirous party. (Fig 6, Col 5, line 62 through Col 6, line 13; and Col 6, line 64 through Col 7, line 18)
- c. The initiating comprises accessing the identifier. (Fig 6, Col 5, line 62 through Col 6, line 13; and Col 6, line 64 through Col 7, line 18)

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- d. Associating the consumable with an image-forming device. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)
- e. First communicating the identifier externally of the image-forming device to identify the marketing function comprising a marketing message for the desirous party after the associating. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)
- f. Receiving a marketing message within the image-forming device responsive to the first communicating. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)
- g. Second communicating the marketing message using the image-forming device. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)

Claim 18: Hayward discloses the method of claim 8 wherein the enabling comprises

- a. Monitoring the consumable utilizing an external device with respect to the image forming device. (Col 9, lines 1-20)
- b. Detecting a status of the consumable reaching a predetermined status. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)

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- c. Wherein the initiating the marketing function comprises forwarding a marketing message to the image-forming device utilizing the external device responsive to the detecting status. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)
- d. Communicating the marketing message using the image-forming device responsive to the detecting status. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)

Claim 19: Hayward discloses the method of claim 8 wherein the making available comprises offering electrical storage space of a memory device of a consumable to the other parties. (Fig 6, Col 5, line 62 through Col 6, line 13; and Col 6, line 64 through Col 7, line 18)

Claim 21: Hayward discloses the article of claim 1 wherein the enabling comprises enabling responsive to the monitoring detecting the association comprising installation of the consumable within the image forming device. (Fig 3, Fig 4, Fig 6, Col 1, line 50 through Col 2, line 16; Col 7, line 54 through Col 8, line 25; Col 8, lines 32-63; and Col 9, lines 33-67)

Claim 22: Hayward discloses the method of claim 8 wherein the enabling comprises storing electrical data related to the marketing function using an electrical memory

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device of the consumable. (Fig 6, Col 5, line 62 through Col 6, line 13; and Col 6, line 64 through Col 7, line 18)

Claim 23: Hayward discloses the method of claim 8, wherein the enabling the marketing function comprises storing marketing message in the form of electrical data using an electrical memory device of the consumable. (Fig 6, Col 5, line 62 through Col 6, line 13; and Col 6, line 64 through Col 7, line 18)

Claim 24: Hayward discloses the method of claim 17 wherein the enabling comprises storing electrical data of the identifier within the memory device comprising an electrical memory device configured to store the electrical data. (Fig 6, Col 5, line 62 through Col 6, line 13; and Col 6, line 64 through Col 7, line 18)

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN VAN BRAMER whose telephone number is (571)272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax

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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John Van Bramer/
Examiner, Art Unit 3622

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